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In re Application of: Mamoru Oguro

Serial No.: 09/996,557

Group Art Unit: 2874

Filed: November 30, 2001

Examiner: Healy, Brian

For: OPTICAL MODULE

Honorable Commissioner of Patents
Alexandria, VA 22313-1450

RESPONSE TO OFFICE COMMUNICATION

Sir:

Receipt of the Office Communication mailed July 2, 2004 is acknowledged. That Communication contends that the Amendment filed May 26, 2004 is not fully responsive to the prior Office Action because "The amendment filed 5/26/04 did not include a clean copy of the claims in compliance with MPEP 714 and 37 CFR 1.121." This contention, and any refusal of entry of the Amendment based on it, are traversed. The Amendment fully meets the requirements of the current revisions of the MPEP 714 and of 37 CFR 1.121, and so is fully responsive to the Office Action.

Attached is a copy of MPEP §714 as downloaded from the Patent and Trademark Office [PTO] web site on July 7, 2004. The Examiner's attention is particularly invited to the penultimate sentence in sub-section C(B) on page 700-209. That paragraph instructs how amended claims are to be presented. The penultimate sentence reads:

"An accompanying clean version is not required and should not be presented."
[Emphasis added.]

Likewise attached is a copy the current revision of 37 CFR 1.121 (which was published in the Official Gazette of July 29, 2003), as downloaded from the PTO web site on July 6, 2004. The Examiner's attention is particularly invited to subsection (c)(3) which reads in part:

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“(3) When claim text in clean version is required. The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of ‘original,’ ‘withdrawn’ or ‘previously presented’ will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of ‘withdrawn’ or ‘previously presented.’”

In contrast with the earlier revision of 37 CFR 1.121, there is no requirement in the current revision for a clean copy of the amended claims. In fact, the Examiner’s approach would constitute a false assertion that the amended claims had not been changed relative to their immediate prior version.

Also attached is a copy of a PTO paper, as downloaded from the PTO web site on July 6, 2004, titled: “Revised Amendment Practice: 37 CFR 1.121 Changed Compliance is Mandatory – Effective Date: July 30, 2003.” [Emphasis added.] Note Section II, which reads:

“Two versions of amended part(s) no longer required:
37 CFR 1.121 has been revised to no longer require two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for substitute specifications under 37 CFR 1.125 has been retained.” [Emphasis in original.]

The May 26, 2004 Amendment did not include a substitute specification.

Further attached is a copy of another PTO paper downloaded from the PTO web site July 6, 2004 and titled: SAMPLE FORMAT FOR REVISED AMENDMENT PRACTICE (Rev. 6/03). That sample amendment includes a marked up copy of the amended claims, but no clean copy.

Additionally attached is a copy of a paper from a mid-2003 PTO program discussing

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the then-new amendment requirements. This copy was additionally downloaded from the PTO web site on July 6, 2004 and is titled: "Revised Amendment Practice 37 CFR 1.121.

Note the lower bulleted section of frame 26, which reads:

Submit only one version of the replacement paragraph or section, or currently amended claims, with markings (i.e., strikethrough, double brackets [[]], or underlining), to show the changes relative to immediate prior version.

The requirement to provide a separate, clean version has been eliminated, except when the applicant submits a substitute specification. [Emphasis added.]

Again, the May 26, 2004 did not include a substitute specification.

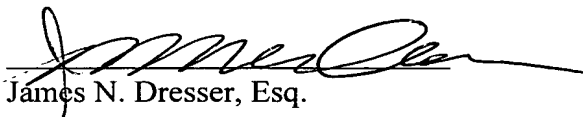
In view of the above, it is respectfully submitted that the Amendment filed May 26, 2004 did not need a clean copy of the claims, but fully complied with the current revision of 37 CFR 1.121 and should be entered.

Examination in accordance with the current revision of 37 CFR 1.121 is respectfully requested.

Respectfully Submitted,

Date:

July 8, 2004



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713.07 Exposure of Other Cases

Prior to an interview in the examiner's room, the examiner should arrange his or her desk so that all files, drawings and other papers, except those necessary in the interview, are placed out of view. See MPEP § 101.

713.08 Demonstration, Exhibits, Models [R-2]

The invention in question may be exhibited or demonstrated during the interview by a model thereof. A model received by the examiner from the applicant or his or her attorney which complies with 37 CFR 1.91 and which is made part of the application record must be properly recorded on the "Contents" portion of the application file wrapper. See MPEP § 608.03 and § 608.03(a). >For Image File Wrapper (IFW) processing, see IFW Manual section 3.6.<

Oftentimes a model or exhibit is not given into the custody of the Office but is brought directly into the *>Technology Center< by the attorney solely for inspection or demonstration during the course of the interview. This is permissible. If the model or exhibit is merely used for demonstration purpose and is not made part of the record (does not comply with 37 CFR 1.91), a full description as to what was demonstrated/exhibited must be made of record in the application. See 37 CFR 1.133(b). Demonstrations of apparatus or exhibits too large to be brought into the Office may be viewed by the examiner outside of the Office (in the Washington, D.C. area) with the approval of the supervisory patent examiner. It is presumed that the witnessing of the demonstration or the reviewing of the exhibit is actually essential in the developing and clarifying of the issues involved in the application.

713.09 Finally Rejected Application

Normally, one interview after final rejection is permitted. However, prior to the interview, the intended purpose and content of the interview should be presented briefly, preferably in writing. Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more

than nominal reconsideration or new search should be denied. See MPEP § 714.13.

Interviews may be held after the expiration of the shortened statutory period and prior to the maximum permitted statutory period of 6 months without an extension of time. See MPEP § 706.07(f).

A second or further interview after a final rejection may be held if the examiner is convinced that it will expedite the issues for appeal or disposal of the application.

713.10 Interview Preceding Filing Amendment Under 37 CFR 1.312

After an application is sent to issue, it is technically no longer under the jurisdiction of the primary examiner. 37 CFR 1.312. An interview with an examiner that would involve a detailed consideration of claims sought to be entered and perhaps entailing a discussion of the prior art for determining whether or not the claims are allowable should not be given. Obviously an applicant is not entitled to a greater degree of consideration in an amendment presented informally than is given an applicant in the consideration of an amendment when formally presented, particularly since consideration of an amendment filed under 37 CFR 1.312 cannot be demanded as a matter of right.

Requests for interviews on cases where a notice of allowance has been mailed should be granted only with specific approval of the Technology Center Director upon a showing in writing of extraordinary circumstances.

714 Amendments, Applicant's Action [R-2]

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37 CFR 1.121. *Manner of making amendments in application.*

(a) *Amendments in applications, other than reissue applications.* Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) *Specification.* Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) Amendment to delete, replace, or add a paragraph.

Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and;

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) Amendment by replacement section. If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and;

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) Amendment by substitute specification. The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) Reinstatement of previously deleted paragraph or section. A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) Presentation in subsequent amendment document.

Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) Claims. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled.

Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) Claim listing. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) When claim text with markings is required. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) When claim text in clean version is required. The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, i.e., without any underlining.

(4) When claim text shall not be presented; canceling a claim.

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the

status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

(d) *Drawings.* One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the header, labeled “Replacement Sheet.” Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. All changes to the drawing(s) shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as “Annotated Marked-up Drawings” and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) *Disclosure consistency.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

(g) *Exception for examiner’s amendments.* Changes to the specification, including the claims, of an application made by the Office in an examiner’s amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner’s amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) *Amendment sections.* Each section of an amendment document (e.g., amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(j) *Amendments in reexamination proceedings.* Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

(k) *Amendments in provisional applications.* Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provi-

sional application shall be placed in the provisional application file but may not be entered.<

I. WHEN APPLICANT MAY AMEND

The applicant may amend:

(A) before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in 37 CFR 1.112;

(B) after final rejection, if the amendment meets the criteria of 37 CFR 1.116; and

(C) when and as specifically required by the examiner.

Amendments in provisional applications are not normally made. If an amendment is made to a provisional application, however, it must comply with the provisions of 37 CFR 1.121. Any amendments to a provisional application will be placed in the provisional application file, but may not be entered.

II. MANNER OF MAKING AMENDMENTS

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All amendments filed on or after July 30, 2003 must comply with 37 CFR 1.121 as revised in the notice of final rule making published in the *Federal Register* on June 30, 2003 at 65 *Fed. Reg.* 38611. The manner of making amendments has been revised to assist in the implementation of beginning-to-end electronic image processing of patent applications. Specifically, changes have been made to facilitate electronic image data capture and processing and streamline the patent application process. If an amendment filed on or after July 30, 2003 does not comply with revised 37 CFR 1.121, the Office will notify applicants via a Notice of Non-Compliant Amendment that the amendment is not accepted. See MPEP § 714.03.

The revised amendment practice is summarized as follows.

A. Amendment Sections

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet to facilitate separate indexing and electronic scanning of each section of an amendment document for placement in an image file wrapper.

It is recommended that applicants use the following format when submitting amendment papers. The amendment papers should include, in the following order:

(A) a cover sheet, or introductory comments, providing the appropriate application information (e.g., application number, applicant, filing date) and which serves as a table of contents to the amendment document by indicating on what page of the amendment document each of the following sections begin;

(B) a section (must begin on a separate sheet) entitled "Amendments to the Specification" (if there are any amendments to the specification). This section should include all amendments to the specification including amendments to the abstract of the disclosure;

(C) a section (must begin on a separate sheet) entitled "Amendments to the Claims" which includes a complete listing of all claims ever presented in the application (if there are any amendments to the claims);

(D) a section (must begin on a separate sheet) entitled "Amendments to the Drawings" in which all changes to the drawings are discussed (if there are any amendments to the drawings);

(E) a remarks section (must begin on a separate sheet); and

(F) any drawings being submitted including any "Replacement Sheet," "New Sheet," or "Annotated Marked-Up Drawings."

B. <Amendments to the Specification

>Amendments to the specification, other than the claims, computer listings (37 CFR 1.96) and sequence listings (37 CFR 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification.< In order to delete, replace or add a paragraph to the specification of an application, the amendment must unambiguously identify the paragraph to be modified either by paragraph number (see MPEP § 608.01), page and line, or any other unambiguous method and be accompanied by **>any replacement or new paragraph(s).** Replacement paragraphs must include markings to show the changes. A separate clean version of any replacement paragraphs is not required. Any new paragraphs must be presented in clean form without any markings (i.e., underlining)<.

Where paragraph numbering has been included in an application as provided in 37 CFR 1.52(b)(6), applicants can easily refer to a specific paragraph by number when presenting an amendment. If a numbered paragraph is to be replaced by a single paragraph, the added replacement paragraph should be numbered with the same number of the paragraph being replaced. Where more than one paragraph is to replace a single original paragraph, the added paragraphs should be numbered using the number of the original paragraph for the first replacement paragraph, followed by increasing decimal numbers for the second and subsequent added paragraphs, e.g., original paragraph [0071] has been replaced with paragraphs [0071], [0071.1], and [0071.2]. If a numbered paragraph is deleted, the numbering of the subsequent paragraphs should remain unchanged.

37 CFR 1.121(b)(1)(ii) requires that the **>full** text of any replacement paragraph be provided with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted subject matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show the deletion of five or fewer consecutive characters (e.g., [[eroor]]). The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived (e.g., deletion of the number "4" must be shown as [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change (e.g., ~~number 4~~ as number 14 as). For added paragraphs, 37 CFR 1.121(b)(2)(iii) requires that the full text of any added paragraph(s) be presented in clean form without any underlining. Similarly, under 37 CFR 1.121(b)(2)(iv), a marked up version does not have to be supplied for any deleted paragraph(s). It is sufficient to merely indicate or identify any paragraph that has been deleted. The instruction to delete may identify a paragraph by its paragraph number, page and line number, or include a few words from the beginning, and end, or the paragraph, if needed for paragraph identification<.

Applicants are also permitted to amend the specification by replacement sections (e.g., as provided in 37 CFR 1.77(b), 1.154(b), or 1.163(c)). As with replacement paragraphs, the amended version of a replacement section is required to be provided ****>**with markings to show all the changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted subject matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show the deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived<.

Applicants are also permitted to amend the specification by submitting a substitute specification, provided the requirements of 37 CFR 1.125(b) >and (c)< are met. An accompanying separate marked up version showing the changes in the specification relative to the previous version is also required.

Any ****>**previously deleted paragraph or section< can only be reinstated by a subsequent amendment presenting the previously deleted subject matter. A direction by applicant to remove a previously entered amendment will not be permitted.

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C. < Amendments to the Claims

****>**Each amendment document that includes a change to an existing claim, including the deletion of an existing claim, or submission of a new claim, must include a complete listing of all claims in the application. After each claim number, the status of the claim must be indicated in a parenthetical expression, and the text of each claim under examination as well as all withdrawn claims (each with markings if any, to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.

(A) The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number by one of the following: (original), (currently amended), (previously presented), (canceled), (withdrawn), (new), or (not entered). The text of all pend-

ing claims under examination and withdrawn claims must be submitted each time any claim is amended. Canceled and not entered claims must be listed by only the claim number and status, without presenting the text of the claims.

(B) All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by strike-through (for deleted matter) or underlining (for added matter) with 2 exceptions: (1) for deletion of five or fewer consecutive characters, double brackets may be used (e.g., ~~[[error]]~~); (2) if strike-through cannot be easily perceived (e.g., deletion of number “4” or certain punctuation marks), double brackets must be used (e.g., ~~[[4]]~~). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change (e.g., ~~number 4 as~~ number 14 as). An accompanying clean version is not required and should not be presented. Only claims of the status “currently amended” or “withdrawn” will include markings.

(C) The text of pending claims not being currently amended, including withdrawn claims, must be presented in clean version, i.e., without any markings. Any claim presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

(D) A claim being canceled must be indicated as “canceled;” the text of the claim must not be presented. Providing an instruction to cancel is optional.

(E) Any claims added by amendment must be indicated as “new” and the text of the claim must not be underlined.

(F) All of the claims in each amendment paper must be presented in ascending numerical order. Consecutive canceled or not entered claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

A canceled claim can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Example of listing of claims:

Claims 1-5 (canceled)

Claim 6 (withdrawn): A process for molding a bucket.

Claim 7 (previously presented): A bucket with a handle.

Claim 8 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 9 (withdrawn): The process for molding a bucket of claim 6 using molten plastic material.

Claim 10 (original): The bucket of claim 8 with a wooden handle.

Claim 11 (canceled)

Claim 12 (previously presented): A bucket having a circumferential upper lip.

Claim 13 (not entered)

Claim 14 (new): A bucket with plastic sides and bottom.<

37 CFR 1.121(g) permits the Office to make amendments to the specification, including the claims, by examiner's amendments without paragraph/section/claim replacement in the interest of expediting prosecution and reducing cycle time. Additions or deletions of subject matter in the specification, including the claims, may be made by instructions to make the change at a precise location in the specification or the claims. >Examiner's amendments do not need to comply with paragraphs (b)(1), (b)(2), or (c) of 37 CFR 1.121.< See MPEP § 1302.04.

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D. <Amendments to the Drawing

**>Any changes to an application drawing must comply with 37 CFR 1.84 and must be submitted on a replacement sheet of drawings. The replacement sheet of drawings must be an attachment to the amendment document and must be identified in the top margin as

"Replacement Sheet." The replacement drawing sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change to the drawings. A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.<

An explanation of the changes made must be presented in >the "Amendments to the Drawings" or< the remarks section of the amendment >document<. If the changes to the drawing figure(s) are not approved by the examiner, applicant will be notified in the next Office action. **

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III. <AMENDMENT IN REEXAMINATION PROCEEDINGS >AND REISSUE APPLICATIONS<

>Amendments in reissue applications must be made in accordance with 37 CFR 1.173. Amendments in *ex parte* and *inter partes* reexamination proceedings must be made in accordance with 37 CFR 1.530.< In patent-owner-filed >*ex parte*< reexaminations, the patent owner may amend at the time of the request for >*ex parte*< reexamination in accordance with 37 CFR 1.510(e). In any >*ex parte*< reexamination proceeding, no amendment or response can be filed between the date of the request for >*ex parte*< reexamination and the order for >*ex parte*< reexamination. See 37 CFR 1.530(a). Following the order for >*ex parte*< reexamination under 37 CFR 1.525 and prior to the examination phase of *>*ex parte*< reexamination proceeding, an amendment may be filed only with the patent owner's statement under 37 CFR 1.530(b). During the examination phase of the >*ex parte*< reexamination proceeding, an amendment may be filed:

(A) after the first examination as specified in 37 CFR 1.112;

(B) after final rejection or an appeal has been taken, if the amendment meets the criteria of 37 CFR 1.116; and

(C) when and as specifically required by the examiner.

See also MPEP § 714.12.

For amendments in *>ex parte<* reexamination proceedings see MPEP § 2250 and § 2266. *>*For amendments by patent owner in an *inter partes* reexamination proceeding, see MPEP § 2666.01 and § 2672. For amendments in reissue applications, see MPEP § 1453.*<*

714.01 Signatures to Amendments

An amendment must be signed by a person having authority to prosecute the application. An unsigned or improperly signed amendment will not be entered. See MPEP § 714.01(a).

To facilitate any telephone call that may become necessary, it is recommended that the complete telephone number with area code and extension be given, preferably near the signature.

714.01(a) Unsigned or Improperly Signed Amendment [R-2]

37 CFR 1.33. *Correspondence respecting patent applications, reexamination proceedings, and other proceedings.*

(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A registered attorney or agent of record appointed in compliance with § 1.34(b);

(2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);

(3) An assignee as provided for under § 3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

An unsigned amendment or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where

the amendment is signed by only one of two applicants and the one signing has not been given a power of attorney by the other applicant.

If copies of papers which require an original signature as set forth in 37 CFR 1.4(e) are filed, the signature must be applied after the copies are made. MPEP § 714.07.

When an unsigned or improperly signed amendment is received the amendment will be listed ****** in the contents of the application file, but not entered. The examiner will notify applicant of the status of the application, advising him or her to furnish a duplicate amendment properly signed or to ratify the amendment already filed. In an application not under final rejection, applicant should be given a 1-month time period in which to ratify the previously filed amendment (37 CFR 1.135(c)).

Applicants may be advised of unsigned amendments by use of form paragraph 7.84.01.

¶ 7.84.01 Paper Is Unsigned

The proposed reply filed on [1] has not been entered because it is unsigned. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Sometimes problems arising from unsigned or improperly signed amendments may be disposed of by calling in the local representative of the attorney or agent of record, since he or she may have the authority to sign the amendment.

An amendment signed by a person whose name is known to have been removed from the registers of attorneys and agents under the provisions of 37 CFR 10.11 is not entered. The file and unentered amendment are submitted to the Office of Enrollment and Discipline for appropriate action.

714.01(c) Signed by Attorney or Agent Not of Record

See MPEP § 405. A registered attorney or agent acting in a representative capacity under 37 CFR 1.34, may sign amendments even though he or she does not have a power of attorney in the application. See MPEP § 402.

Sec. 1.121 Manner of making amendments in applications.

(a) Amendments in applications, other than reissue applications. Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with Sec. 1.52, directing that specified amendments be made.

(b) Specification. Amendments to the specification, other than the claims, computer listings (Sec. 1.96) and sequence listings (Sec. 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) Amendment to delete, replace, or add a paragraph. Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) Amendment by replacement section. If the sections of the specification contain section headings as provided in Sec. 1.77(b), Sec. 1.154(b), or Sec. 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any

deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) Amendment by substitute specification. The specification, other than the claims, may also be amended by submitting:

- (i) An instruction to replace the specification; and
- (ii) A substitute specification in compliance with Secs.

1.125(b) and (c).

(4) Reinstatement of previously deleted paragraph or section. A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) Presentation in subsequent amendment document. Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be re-presented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) Claims. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) Claim listing. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) When claim text with markings is required. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is

currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) When claim text in clean version is required. The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, i.e., without any underlining.

(4) When claim text shall not be presented; canceling a claim.

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) Reinstatement of previously canceled claim. A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

(d) Drawings. One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with Sec. 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the header, labeled "Replacement Sheet." Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. All changes to the drawing(s) shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) Disclosure consistency. The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) No new matter. No amendment may introduce new matter into the disclosure of an application.

(g) Exception for examiner's amendments. Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions

to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) Amendment sections. Each section of an amendment document (e.g., amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) Amendments in reissue applications. Any amendment to the description and claims in reissue applications must be made in accordance with Sec. 1.173.

(j) Amendments in reexamination proceedings. Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with Sec. 1.530.

(k) Amendments in provisional applications. Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

**REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED
COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003**

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.

Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE

I. Begin each section of an amendment document on a separate sheet:

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:

37 CFR 1.121 has been revised to **no longer require two versions** (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for **substitute specifications** under 37 CFR 1.125 have been retained.

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and **the text of each pending claim** (with markings to show **current** changes) must be presented. The claims in the listing will replace all prior claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), **(previously presented) and (not entered)**. The text of all pending claims, **including withdrawn claims**, must be submitted each time any claim is amended. Canceled **and not entered** claims must be indicated by only the claim number and status, without presenting the text of the claims.
- (2) The text of all claims **being currently amended** must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for **deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]).** As an alternative to using double brackets, however, **extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as).** An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.
- (3) The text of pending claims **not being currently amended, including withdrawn claims**, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

- (4) A claim being canceled must be listed in the claim listing with the status identifier “canceled”; the text of the claim must not be presented. Providing an instruction to cancel is optional.
- (5) Any claims added by amendment must be presented in the claim listing with the status identifier “(new)”; the text of the claim must not be underlined.
- (6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

Example of listing of claims (use of the word “claim” before the claim number is optional):

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number “4” or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., ~~number 4 as~~ number 14 as)

C) Amendments to drawing figures:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations. Any replacement drawing sheet must be identified in the top margin as “Replacement Sheet” and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. Any marked-up (annotated) copy showing changes must be labeled “Annotated Marked-up Drawings” and accompany the replacement sheet in the amendment (e.g., as an appendix). The figure or figure number of the amended drawing(s) must **not** be labeled as “amended.” If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to patentpractice@uspto.gov or by phone at (703) 305-1616.

Revised Amendment Practice 37 CFR 1.121

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Revised Amendment Practice

- **Strict compliance is mandatory** - all amendments filed on or after July 30, 2003 must comply with the revised 37 CFR 1.121, except amendments to the specification and claims filed in reissue applications and reexamination proceedings.
- A sample amendment document and Q's and A's are posted on the USPTO's website at <http://www.uspto.gov/web/offices/pac/dapp/opla/pr/eognotice/moreinfoamdtprac.htm>

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Revised Amendment Practice (Continued)

- Major Changes from Notice of Proposed Rule Making :
 - ⌚ Only seven status identifiers are permissible instead of eleven.
 - ⌚ The text of withdrawn claims must be included in the listing of the claims.
 - Comments on the NPR suggested supplying text of withdrawn claims for rejoinder purposes.
 - Applicants may need to amend withdrawn claims to include limitations added to elected claims to permit rejoinder.
 - ⌚ Drawing changes may be shown by annotated drawings.
 - ⌚ Permissible markings only include underlining, strikethrough, and double brackets [[]].
- Note: changes from NPR are highlighted in bold on the next few slides.

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Revised Amendment Practice (Continued)

Highlights:

- Each section of an amendment paper must start on a separate sheet.
 - ⌚ For example: each of the following sections must start on a separate sheet: Introductory comments, Amendments to the Specification, Amendments to the Claims, Amendments to Drawings, and Remarks.
- Submit only one version of the replacement paragraph or section, or currently amended claims, with markings (*i.e.*, strikethrough, **double brackets** [[]], or underlining), to show the changes relative to immediate prior version.
 - ⌚ The requirement to provide a separate, clean version has been eliminated, except when applicant submits a substitute specification.

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Amendments to Claims

- When there is any amendment to a claim, a claim listing of all claims ever presented in the case must be supplied in ascending numerical order.
- An example of a claim listing is as follows:
 - Claims 1-5 (canceled)
 - Claim 6 (previously presented) A bucket with a handle.
 - Claim 7 (withdrawn) A handle comprising an elongated wire.
 - Claim 8 (withdrawn) The handle of claim 7[[6]] further comprising a plastic grip.
 - Claim 9 (currently amended) A bucket with a ~~green-blue~~ handle.
 - Claim 10 (original) The bucket of claim 9 wherein the handle is made of wood.
 - Claim 11 (canceled)
 - Claim 12 (not entered)
 - Claim 13 (new) A bucket with plastic sides and bottom.

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Amendments to Claims (continued)

- What is a claim listing?
 - A claim listing must include:
 - The claim number of every claim ever presented in the application, whether entered or not;
 - A status identifier, in parentheses, following each claim number;
 - The text of all pending claims (including **withdrawn** claims); and
 - Markings to show the changes made only in the current amendment relative to immediate prior version.
 - The claims in the listing (in the current amendment) will replace all prior versions, and listings, of claims in the application.

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Amendments to Claims (continued)

- The seven (7) permissible status identifiers and their definitions, are:
 - **(Original):** Claim filed with original specification (not added by preliminary amendment and not previously amended).
 - **(Currently amended):** Claim being amended in the current amendment. Currently amended claims must include markings (strikethrough, double brackets, or underlining) to indicate changes.
 - **(Canceled):** Claim canceled or deleted in current amendment or previously. Do not present the text of a canceled claim. Consecutive canceled claims may be grouped together (e.g., claims 1-5 (canceled)).

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Amendments to Claims (continued)

- Seven (7) permissible status identifiers (cont.):
 - **(Withdrawn):** Non-elected claim.
 - The text of a withdrawn claim must be presented.
 - Withdrawn claims that are being currently amended must be presented with markings (strikethrough, double brackets, or underlining) to indicate changes.
 - Example: Claim 8 (withdrawn) The handle of claim 7 further comprising a plastic grip.
 - **(Previously presented):** This is a generic identifier to cover any claim that was previously added or amended in an earlier amendment paper.
 - The proposed identifiers "previously amended" or "previously added" were not adopted, and must not be used.

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Amendments to Claims (Continued)

- **Seven (7) permissible status identifiers (cont.):**
 - **(New):** Claim being added in the current amendment paper. The text of the claim must be presented in clean form without underlining.
 - **(Not entered):** Claim presented in a previous unentered amendment.
 - Do not present the text of a not entered claim.
 - Consecutive not entered claims may be grouped together (e.g., Claims 20-25 (not entered)).
 - If in doubt as to whether a prior amendment was entered, the claim should be presumed to be "not entered".

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Amendments to Claims (Continued)

- **The following status identifiers in NPR have been eliminated:**
 - previously amended,
 - previously added,
 - reinstated-formerly claim #_,
 - previously reinstated,
 - re-presented-formerly dependent claim #_,
 - and
 - previously re-presented.

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Amendments to Claims (continued)

- Multiple status identifiers must not be used for any single claim.
- Only claims of the status “currently amended” and “**withdrawn**” (if the **withdrawn** claims are being currently amended) may include markings.
- All other pending claims (including **withdrawn** claims that are not being currently amended) must be presented in clean text (without markings).

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Amendments to Claims (continued)

- Any claim presented in clean text (no markings) constitutes an assertion that it has not been changed relative to the immediate prior version, except omitting markings (*i.e.*, underlining, strikethrough, and double brackets) and deleted text.
 - For example,
 - If the immediate prior version of the claim was:
“Claim 1 (currently amended) A bucket with a blue handle.”
 - The listing of claims in the current amendment must have:
“Claim 1 (previously presented) A bucket with a handle.”

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Amendments to Claims (continued)

- Canceled claims and **not entered** claims may only have a "canceled" or "not entered" status identifier after the claim number. The text must not be supplied.
- Grouping of Claims – consecutive canceled claims or **not entered** claims may be aggregated into one line.
 - ✧ Examples: Claims 1-5 (canceled)
 Claims 20-25 (not entered)
- New or added claims must have "new" as a status identifier
 - ✧ Do not underline the text of the new claims.

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Revised Amendment Practice (Continued)

- Markings to Show Changes:
 - ✧ The following must include markings to show all changes relative the immediate prior version:
 - Replacement paragraphs or sections,
 - Replacement abstracts,
 - Currently amended claims, and
 - Substitute specifications.
 - ✧ Added text must be shown by underlining.
 - ✧ Deleted text must be shown by **strikethrough** with 2 exceptions.

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Revised Amendment Practice (Continued)

■ Markings to Show Changes (cont')

■ Deleted text must be shown by **strikethrough** (e.g., ~~strikethrough~~), with 2 exceptions:

- For deletion of five or fewer consecutive characters, **double brackets** **[[]]** may be used (e.g., ~~error~~); and
- If strikethrough cannot be easily perceived, deleted text must be shown by **double brackets** **[[]]** around the deleted text characters.
 - For example: changing "4 corners" to "three corners" should be indicated by "three~~4~~ corners".

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Revised Amendment Practice (Continued)

■ Markings to Show Changes (cont')

■ For changes of punctuation marks or difficult to perceive characters, applicants may delete text before and after with strikethrough, and then insert such text along with the change by underlining. For example:

- If the hyphen in "strike-through" is to be deleted, it may be shown as "~~strike-through~~strikethrough"

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Amendments to Specification

- The location of the paragraph or section to be deleted or replaced, or where a new paragraph or section is to be added, must be unambiguously identified.
 - The location can be identified by using a few words at the beginning and/or the end of the paragraph or section.
- Do not underline the text of a new paragraph or section.
- Deletion of a paragraph or section must only include an instruction to delete, and the location of the paragraph or section.
- Replacement paragraph or section must be a marked-up version showing the changes.
- A clean version of any replacement paragraph or section must not be submitted in addition to a marked up version, except when applicant submits a substitute specification.

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Amendments to Abstract

- An amendment to an abstract is treated like an amendment to the specification.
 - If the changes are minor in nature, submit a replacement abstract with markings to show all changes relative to the immediate prior version.
 - If the abstract is being substantially rewritten, submit a new abstract in clean text (no markings) accompanied by an instruction for the cancellation of the previous abstract.
 - Any new, or replacement, abstract must be submitted on a separate sheet (37 CFR 1.72).

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Substitute Specification

- **Substitute Specification under 37 CFR 1.125 requires:**
 - A statement that the substitute specification includes no new matter.
 - A specification with markings to show all the changes relative to the immediate prior version.
 - A **clean version** (without markings) of the substitute specification.
 - The requirements of a marked-up version and a clean version have been retained.

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Amendments to Drawings

- **Amendment to drawings must include:**
 - **Replacement drawing sheet** showing amended figures which include the desired changes, without markings, on a separate sheet in compliance with §1.84; and
 - **Explanation of the changes** in the remarks, or preferably, in the drawing amendments section, of the amendment paper.
 - **Optional unless required by examiner:**
 - **Annotated drawing sheet** – a marked-up copy of the amended figure(s) with annotations showing the change(s) may be submitted, or required by the examiner.

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Amendments to Drawings (Continued)

- Replacement drawing sheet(s) must be identified in top margin as **"Replacement Sheet"**.
- Annotated drawing sheet(s) must be identified in top margin as **"Annotated Marked-up Drawings"**.
 - This will avoid confusion between a replacement sheet and an annotated sheet.
 - Annotated drawing sheet(s) will not be entered as part of the official drawing(s) for the application.
- The replacement drawing sheet(s) and annotated drawing sheet(s), if any, should follow the last page of the amendment paper, as attachment(s).

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Amendments to Drawings (Continued)

- Proposed drawing correction process is eliminated.
- Replacement drawing sheet with changes is accepted by examiner, unless otherwise notified by examiner. No further drawing submission is required.
- If not acceptable, applicants will be notified of any objections or additional requirements.

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Amendments to Drawings (Continued)

- Any replacement drawing sheet including amended figures must include all of the figures appearing on the immediate prior version of the sheet.
- The replacement drawing figure must not be labeled as "amended."
- 37 CFR 1.173 now provides for amending drawings in reissue applications in a similar manner.

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Amendments to Drawings (Continued)

- Deletion of a figure requires the following:
 - An instruction to delete the figure;
 - A replacement sheet which does not include the canceled figure, unless no other figure is on the same sheet as the canceled figure;
 - Amendment to the specification to make corresponding changes to the description of the drawings (e.g., deletion of the description of the canceled figure); and
 - If other figures need to be renumbered, those figures also need to be amended with revised figure numbers via replacement drawing sheets.

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After Final Amendments

- Any amendment after final (§1.116), or amendment filed with a request for continued examination (RCE) under §1.114, must include markings showing the changes relative to the last entered amendment.
 - Do not include markings to show changes relative to any unentered amendment.
 - Applicant should not assume that an after final amendment is entered because after final amendments are not entered as a matter of right (§1.116).

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After Final Amendments (Continued)

- If applicant has not received an advisory action, applicant should check via PAIR, or call the examiner, to determine whether the after final amendment has been entered before filing another after final amendment or an amendment with an RCE.
- If the advisory action has indicated that an after final amendment will be entered upon the filing of an appeal, applicant should assume that the after final amendment is not entered.
 - Any subsequent amendment must include markings showing the changes relative to the last entered amendment, and not the amendment which the advisory action indicated will be entered upon the filing of an appeal.

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After Final Amendments (Continued)

- If applicant wishes to file an RCE after filing more than one after final amendment that has not been entered, applicant is encouraged to file an amendment with the RCE that includes:
 - Instructions not to enter the unentered after final amendments; and
 - All of the desired changes, including changes presented in the unentered after final amendments.
 - The markings must show changes relative to the last entered amendment.
 - A claim listing which includes any unentered claims presented using the status identifier "not entered" (e.g., claims 20-25 (not entered)).
 - Any new claims must be numbered consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not).

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Treatment of Non-Compliant Amendments

- Applicants will be notified of any amendment paper that is not accepted because the changes do not comply with revised §1.121.
 - For preliminary amendments and replies to non-final Office actions or notices,
 - A Notice of Non-Compliant Amendment identifying the problem section(s) will be mailed; and
 - A period for reply shall be given; but
 - Patent term adjustment (PTA) reductions may be incurred. See §1.704(c)(7).
 - For after-final amendments,
 - Non-compliance will be indicated in an advisory action; and
 - The time period for reply continues to run from the mailing date of the final Office action.
- See MPEP 714.03 (8th Ed. 1st Rev., Feb. 2003).

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Treatment of Non-Compliant Amendments (Continued)

- The Notice of Non-Compliant Amendment will identify:
 - Each section of the amendment that is not in compliance with 37 CFR 1.121;
 - Items that are required for compliance; and
 - The reasons why the section of the amendment fails to comply with 37 CFR 1.121.
- In reply to the Notice, applicants must submit the **corrected section of the amendment** that was non-compliant.
 - Re-submission of the entire amendment is not required.
 - The entire section, however, with corrections, must be resubmitted.
- The Office will only enter the sections of the amendment that are in compliance with 37 CFR 1.121.

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Example

- Non-compliant claim amendment example:
 - If an amendment includes:
 - (1) amendments to the specification, and
 - (2) amendments to the claims, including adding new claims 21 – 25,
 - But the amendments to the claims were non-compliant,
 - Because the claim listing did not include a status identifier for each claim,
- A Notice of Non-Compliant Amendment will be mailed.

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